

REMARKS

Summary

Claims 1-11 and 17-30 stand in this application. Claims 12-16 have been canceled without prejudice. Claims 1, 3, 4, 17, 19, 24, 26 have been amended. No new matter has been added. Favorable reconsideration and allowance of the standing claims are respectfully requested.

Double Patenting

Claims 1 and 3-6 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 7, and 8 of copending Application No. 10/816451.

Claims 2 and 7-11 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 7, and 8 of copending Application No. 10/816451 in view of Fette et al. (U.S. Patent No. 4,862,407).

A terminal disclaimer has been filed herewith, and removal of this rejection is respectfully requested.

35 U.S.C. § 102

At page 4, paragraph 6 of the Office Action claims 1, 2 and 7-11 stand rejected under 35 U.S.C. § 102 as being anticipated by United States Patent Number (USPN) 4,862,407 to Fette et al. (hereinafter "Fette"). Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the anticipation rejection.

Although Applicant disagrees with the broad grounds of rejection set forth in the Office Action, Applicant has amended claims 1, 3, 4, 17, 19, 24, 26 in order to facilitate prosecution on the merits. Claims 1, 17 and 24 have been amended to include claim limitations from dependent claims 3, 4, 19 and 26. Claims 3 and 4 have been rejected under 35 U.S.C. § 103 as being unpatentable over Fette in view of USPN 6,725,364 to Crabill (hereinafter "Crabill"). Claims 19 and 26 have been rejected under 35 U.S.C. § 103 as being unpatentable over USPN 6,081,888 to Bell et al. (hereinafter "Bell") in view of Crabill. Therefore, Applicant will also address the rejections with respect to Crabill below.

Applicant respectfully submits that to anticipate a claim under 35 U.S.C. § 102, the cited reference must teach every element of the claim. *See* MPEP § 2131, for example. Applicant submits that Fette fails to teach each and every element recited in claims 1, 2 and 7-11 and thus they define over Fette. For example, with respect to claim 1, Fette fails to teach, among other things, the following language:

a control unit having a control unit state machine module configured with a fuse map to control execution of said plurality of functions, said control unit to select a function to execute using a function identifier.

According to the Office Action at paragraph 22, this language is disclosed by Fette at column 8, lines 8-29. Applicant respectfully disagrees. Fette at the given cite, in relevant part, states:

FIG. 3 shows a more detailed block diagram of coprocessor 20 than is shown by FIG. 2. Specifically, last value (LV) bus 43 couples to an input of a function register 80 within microsequencer 27. An output of function register 80 couples to an address input of a microcode ROM 82. Microcode ROM 82 contains data which represents the microcode or program that controls coprocessor 20. An

output from microcode ROM 82 couples to an input of an instruction register 83. An output from instruction register 83 provides microsequencer control bus 42. A literal field of control bus 42 couples back to the address input of microcode ROM 82 and to an input of a loop register 91. An output of loop register 91 also couples back to the address input of microcode ROM 82. A microprogram counter 88 has an output which couples to an input of a last in, first out (LIFO) memory 90, a first input of an arithmetic unit 86, and the address input of microcode ROM 82. A set of terminals 87, which are adapted to provide a logical 1 value, couples to a second input of arithmetic unit 86, and an output of arithmetic unit 86 couples to an input of microprogram counter 88.

Fette, at the given cite, arguably discloses a coprocessor that utilizes microcode and an instruction register. In contrast, the claimed subject matter discloses "a control unit having a control unit state machine module configured with a fuse map." Applicant respectfully submits that a coprocessor that uses microcode and an instruction register is clearly different than a control unit state machine module that is configured in accordance with a fuse map.

Moreover, the Office Action at paragraph 21 correctly states that Fette fails to disclose a fuse map. The Office Action cites Crabill as disclosing a fuse map. The Office Action states that Crabill discloses "programmable gate array microcode storage" and "since microcode storage is programmable gate array storage, the configuration parameters inherently include a fuse map." Applicant respectfully disagrees. Applicant respectfully submits that "to establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) Applicant

respectfully submits that the cited portions of Crabill fail to disclose a fuse map and that the Office Action has not made a clear showing that a fuse map is necessarily present within microcode storage. Therefore, the Office Action has not met its required burden of proof. *See* MPEP 2112 Section IV. Applicant argues that it is not necessary for microcode storage to contain a fuse map. Consequently, Fette and Crabill fail to disclose all the elements or features of the claimed subject matter. Accordingly, Applicant respectfully requests removal of the anticipation rejection with respect to claim 1. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claims 2 and 7-11, which depend from claim 1 and, therefore, contain additional features that further distinguish these claims from Fette.

Claims 17, 18, 22, 24, 25, and 29 were rejected under 35 USC § 102(e) as being anticipated by Bell. Applicant respectfully traverses the rejection, and requests reconsideration and withdrawal of the anticipation rejection.

Applicant respectfully submits that to anticipate a claim under 35 U.S.C. § 102, the cited reference must teach every element of the claim. *See* MPEP § 2131, for example. Applicant submits that Bell fails to teach each and every element recited in claims 17, 18, 22, 24, 25 and 29 and thus they define over Bell. For example, with respect to claim 17, Bell fails to teach, among other things, the following language:

receiving configuration information including a fuse map;
configuring a control unit having a control unit state machine module with said configuration information

As correctly noted by the Office Action at paragraph 26, this language is not disclosed by Bell. The Office Action at paragraph 26 cites Crabill as teaching the missing language. Claim 17 recites language similar to that recited within claim 1.

Therefore, Applicant respectfully submits that claim 17 defines over Crabill for reasons analogous to those presented with respect to claim 1. Consequently, Bell and Crabill fail to disclose all the elements or features of the claimed subject matter. Accordingly, Applicant respectfully requests removal of the anticipation rejection with respect to claim 17. Furthermore, Applicant respectfully requests withdrawal of the anticipation rejection with respect to claims 18 and 22, which depend from claim 17 and, therefore, contain additional features that further distinguish these claims from Bell and Crabill.

35 U.S.C. § 103

Claims 3-6 were rejected under 35 USC § 103(a) as being unpatentable over Fette in view of Crabill. Claims 19 and 26 were rejected under 35 USC § 103(a) as being unpatentable over Bell in view of Crabill. Claims 20, 21, 23, 27, 28, and 30 were rejected under 35 USC § 103(a) as being unpatentable over Bell in view of Fette. Applicant respectfully traverses these rejections, and requests reconsideration and withdrawal of the obviousness rejections.

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to MPEP § 2143, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success

must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

As recited above, to form a *prima facie* case of obviousness under 35 U.S.C § 103(a) the cited references, when combined, must teach or suggest every element of the claim. See MPEP § 2143.03, for example. Applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness because the cited references, taken alone or in combination, fail to teach or suggest every element recited in claims 3-6, 19-21, 23, 26-28 and 30. Therefore claims 3-6, 19-21, 23, 26-28 and 30 define over the cited references whether taken alone or in combination.

Claims 3-6, 19-21, 23, 26-28 and 30 are dependent upon claims 1, 17 and 24. Applicant respectfully submits that if an independent claim is non-obvious under 35 U.S.C. § 103, then any claim depending therefrom is non-obvious. See MPEP § 2143.03, for example. As discussed above, Applicant respectfully submits that Fette, Bell and Crabill fail to teach or suggest every element of claims 1, 17 and 24, whether taken alone or in combination. Therefore, claims 3-6, 19-21, 23, 26-28 and 30 are non-obvious and patentable over the cited references based upon their dependency from claims 1, 17 and 24, as well as on their own merits. Accordingly, removal of the obviousness rejection with respect to claims 3-6, 19-21, 23, 26-28 and 30 is respectfully requested.

Conclusion

For at least the above reasons, Applicant submits that claims 1-11 and 17-30 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by

the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

Applicant does not otherwise concede, however, the correctness of the Office Action's rejection with respect to any of the dependent claims discussed above. Accordingly, Applicant hereby reserves the right to make additional arguments as may be necessary to further distinguish the dependent claims from the cited references, taken alone or in combination, based on additional features contained in the dependent claims that were not discussed above. A detailed discussion of these differences is believed to be unnecessary at this time in view of the basic differences in the independent claims pointed out above.

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Examiner: Geib, Benjamin P.
TC/A.U. 2181

It is believed that claims 1-11 and 17-30 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the present patent application.

Respectfully submitted,

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Under 37 CFR 1.34(a)

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